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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/632,539 | 07/31/2003 | Matthew M. Winkler | ASUR:022US | 2672 |

62619 7590 04/17/2007
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| EXAMINER |
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CHUNDURU, SURYAPRABHA

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| ART UNIT | PAPER NUMBER |
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1637

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/17/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|---|---------------------------------------|--|
| Office Action Summary | Application No. 10/632,539 | Applicant(s) WINKLER ET AL. | |
| | Examiner Suryaprabha Chunduru | Art Unit 1637 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-104 and 108-116 is/are pending in the application.
- 4a) Of the above claim(s) 68-78,80-82,103 and 104 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-67,79 and 83-102, 108-116 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants' response to the office action filed on February 05, 2007 has been considered and acknowledged.

Status of the Application

2. Claims 52-67, 79, 83-102, 108-116 are pending Claim 52, 108, 111 are amended. Claims 1-51, 105-107 are canceled. Claims 68-78, 80-82, 103-104 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group. All amendments and arguments have been thoroughly reviewed and deemed persuasive in part for the reasons that follow. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. This action is made Final.

Response to arguments:

3. With regard to the objection to the specification, Applicants' amendment and arguments are fully considered and found persuasive and the rejection is withdrawn herein in view of the amendment.

4. With regard to the rejection of claims 52-67, 79, 85-92, 94-101, 105-107 under 35 USC 102(b) as being anticipated by Kato et al., Applicants' arguments and amendment are fully considered and found unpersuasive. Applicants argue that Kato et al. teach multiple steps to tag a cDNA molecule including preparing cDNA, restriction digestion of cDNA, and adaptor ligation to the digested cDNA, in contrast the currently amended claim 52 is superior to the method described by Kato et al. because cDNA is tagged simultaneously with its synthesis by reverse transcription. Applicants' arguments are found unpersuasive. First, the instant claims are in 'comprising' open language format, thus according to MPEP 2111.03, any unrecited steps are within the scope of

the claims. Second, with regard to the argument that the instant method is superior to the method over Kato et al. examiner notes that Applicants have not provided any unexpected results compared to the prior art of the record. Third, the limitations upon which the arguments are based, that is the limitations 'cDNA is tagged simultaneously with its synthesis by reverse transcription' are not present in the instant claims. As noted in the MPEP 2145 although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further the amended claim 52 does not change the scope of the claims because the tagging by hybridization and extending the tag to prepare the tagged nucleic acid sample are within the scope of the teachings of Kato et al. as discussed in the rejection. Therefore the rejection is maintained for these claims.

With regard to the claims 113-116, Applicants' arguments are fully considered and found unpersuasive. Applicants argue that the claims involve nucleic acid fingerprint analysis as disclosed in the specification and Examiner has not shown that Kato et al teaches said analysis as recited in the claims 113-116. Examiner notes that the claims are addressed in the rejection. However as discussed above according to MPEP 2145, the specification can not be read into the claims, thus the limitation (fingerprint analysis) upon which the arguments are based is not present in the claims. Accordingly the rejection is maintained herein.

5. With regard to the rejection of claim 93, under 35 USC 103(a) over Kato in view of Wang, Applicants' arguments and amendment are fully considered and found unpersuasive. Applicants argue that Kato et al. does not teach the limitations in the independent claim 52 as amended and therefore the claim 93 which is dependent on the claim 52 is non-obvious. Applicants' arguments

are fully considered and found unpersuasive. As discussed above, Kato does teach the instant amended claim 52 and any unrecited elements as stated in MPEP 2111.03 are within the scope of the instant claims. Therefore the combination of Kato et al. and Wang does make the instant claim obvious as discussed in the rejection. Accordingly the rejection is maintained herein.

6. With regard to the rejection of claims 102 and 108-112 under 35 USC 103(a) over Kato et al. in view of Carey, Applicants' arguments and amendment are fully considered and found unpersuasive. Applicants argue that Kato et al. does not teach the limitations in the independent claim 52 as amended and therefore the claim 93 which is dependent on the claim 52 is non-obvious. Applicants' arguments are fully considered and found unpersuasive. As discussed above, Kato does teach the instant amended claim 52 and any unrecited elements as stated in MPEP 2111.03 are within the scope of the instant claims. Therefore the combination of Kato et al. and Carey does make the instant claim obvious as discussed in the rejection. Accordingly the rejection is maintained herein.

Conclusion

No claims are allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Suryaprabha Chunduru
Primary Examiner,
Art Unit 1637

Suryaprabha Chunduru
SURYAPRABHA CHUNDURU 4/12/07
PRIMARY EXAMINER